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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,485	03/04/2005	Yasuo Uemura	028567-0141	1855

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FOLEY AND LARDNER LLP
SUITE 500
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WASHINGTON, DC 20007

EXAMINER

PE, GEEPY

ART UNIT	PAPER NUMBER
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2621

MAIL DATE	DELIVERY MODE
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03/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,485	Applicant(s) UEMURA ET AL.	
	Examiner Geepy Pe	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/4/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/4/05, 3/20/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A) The Examiner notes that "A program..." or "...record[ing] a program..." does not specify how the instructions are (a) associated with the medium, or (b) the nature of instructions. Data structures not claimed as embodied (or encoded with or embedded with) in a computer readable medium are descriptive material per se, and are not statutory, *Warmerdam*, 33 F.3d at 1361, 31, USPQ2d at 1760). Similarly, computer programs claimed as computer listings, instructions, or codes are just the descriptions, expressions, of the program are not "physical things". They have neither computer components nor statutory processes, as they are not "acts" being performed. In contrast, a claimed "... computer readable medium encoded with a computer program..." is a computer element which defines structural and function interrelationships

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between the computer program and the rest of the computer, and is statutory, *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035, *Interim Guidelines, Annex IV (Section a)*.

B) The computer program as claimed is not properly associated with the operation. It is quite possible that the computer program may be an unrelated sub-routine or a simple commence instruction which then causes the computer to execute the operation that could be self-resident, and not encoded on the medium, *Interim Guidelines, Annex IV (Section b)*.

C) Claims that recite nothing but the physical characteristics of a form of energy, such as frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*, and as such are nonstatutory natural phenomena (Specification, pg. 61, lines 22-25), *O'Reilly*, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set for in § 101.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims **1-10** are rejected under 35 U.S.C. 102(b) as being anticipated by Bacus et al. (U.S. Pat. 6,226,392; hereinafter Bacus; already of record).

Re. **claim 1**, Bacus teaches a microscope image processing system (Bacus: Title) comprising: an integrative photographing unit that integratively photographs each sample

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holding portion of a sample holder at a predetermined magnification with a microscope (Bacus: col. 7, lines 19-25 & 31-35; Figs. 4B, 5); a thumbnail displaying unit that displays image files photographed by said integrative photographing unit as thumbnails (Bacus: Figs. 1, 2, 11; col. 7, lines 35-50); an individual photographing information designating unit that designates individual photographing information concerning locations and magnifications of samples that a user wishes to photograph, said information corresponding to said image files that said user selects from said image files displayed on said thumbnail displaying unit (Bacus: Figs. 1-3; col. 7, lines 35-50; Fig. 6, step 209a); and an individual photographing unit that photographs each part within said sample holding portion in accordance with said locations and magnifications designated by said individual photographing information (Bacus: Figs. 9, 10).

Re. **claim 2**, Bacus teaches that said individual photographing information designating unit displays on a monitor an individual photographing information designating screen for allowing said user to designate said individual photographing information, and creates said individual photographing information from coordinate information and magnification information that said user designates on said individual photographing information designating screen via an input device (Bacus: Figs. 1-3, 4B, 5, 9-11).

Re. **claim 3**, Bacus teaches that said individual photographing information designating unit automatically determines any one or both of said coordinate information and magnification information for photographing by an image processing procedure and thereby creates said individual photographing information (Bacus: Figs. 1-3, 4B, 5, 9-11: i.e., the system creates tiles and, automatically, with each tile comes X and Y coordinates defining the edges for each tile).

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Re. **claims 4, 7, and 10**, the claim(s) recite analogous limitations to claim(s) 1 above, and is/are therefore rejected on the same premise. Regarding claims 7 and 10, Bacus describes hard disks containing programs for controlling and operating the microscope accordingly.

Re. **claims 5 and 8**, the claim(s) recite analogous limitations to claim(s) 2 above, and is/are therefore rejected on the same premise.

Re. **claims 6 and 9**, the claim(s) recite analogous limitations to claim(s) 3 above, and is/are therefore rejected on the same premise.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geepy Pe whose telephone number is (571)-270-3703. The examiner can normally be reached on Monday - Friday, 7:00AM - 3:30PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. P./

/Geepy Pe/

Examiner, Art Unit 2621

/Andy S. Rao/

Primary Examiner, Art Unit 2621

March 23, 2009